

AF/1616
JFW

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Kanji TAKADA : Group Art Unit.: 1616
Serial No.: 09/787,612 : Examiner: GOLLAMUDI, Sharmila S.
Filed: March 20, 2001 :
Title: ORAL DRUG DELIVERY SYSTEM FOR ENHANCING THE
BIOAVAILABILITY OF ACTIVE FORM OF GLYCYRRHIZIN

REPLY

Box: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In response to the Notification of Non-Compliance dated September 27, 2004, alleging that the claims in the appendix of the Brief on Appeal are incorrect because the "record clearly indicates that the after-final claims of May 4, 2004, were not entered," applicants attach a copy of the Advisory Action dated May 4, 2004, where box 7, choice b) is X-ed indicating that for purposes of Appeal the amendment will be entered. The relevant section is reproduced below:

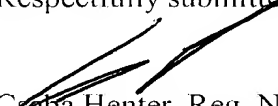
7. ☒ for purposes of Appeal, the proposed amendment(s)
a) ☐ will not be entered or b) ☒ will be entered ...

While the Advisory Action in question indicates that the claims are not entered, it clearly indicates that for purposes of Appeal, they would be entered. Applicants relying on this prepared and filed a Brief on Appeal assuming the claims on appeal would be ones with the amendments entered as indicated in the Advisory Action.

Applicants accordingly request that the amendments to the claims be entered as indicated, or other equitable remedy be provided, for example, reopening of prosecution with entry of the amendments.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

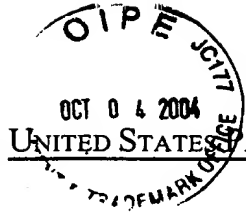
Respectfully submitted,



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Filed: October 4, 2004

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,612	03/20/2001	Kanji Takada	AKA-269	4679

23599 7590 05/04/2004

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 05/04/2004

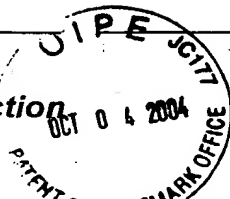
Please find below and/or attached an Office communication concerning this application or proceeding.

URGENT

NOA/TRANS. 1 MO. EOT
5/20/04

D/KF-D
5/6/04
AA

Advisory Action



Application No.

09/787,612

Applicant(s)

TAKADA, KANJI

Examiner

Sharmila S. Gollamudi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The applicant has not shown that the process in which the product is made provides a patentable difference to the product. Patentability is based on the product itself, which has been rejected under 103 (a). See MPEP 2113. Therefore, amendments made to include process limitations does not place the application in better form for appeal. It should be noted that applicant is not entitled to rejoinder of the process and product claims since the process claims were introduced mid-prosecution and applicant had already received an action on the originally presented claims (product claims).

THURMAN K. PAGE
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